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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/848,737	05/03/2001	Daniel Schoeffler	SDA-1	8033
20808	7590	09/23/2004	EXAMINER	
BROWN & MICHAELS, PC 400 M & T BANK BUILDING 118 NORTH TIOGA ST ITHACA, NY 14850			NGUYEN, PHUOC H	
			ART UNIT	PAPER NUMBER
			2143	

DATE MAILED: 09/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/848,737

Applicant(s)

SCHOEFFLER, DANIEL

Examiner

Phuoc H. Nguyen

Art Unit

2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☐ Claim(s) \_\_\_\_ is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-67 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-6,12-17,20,21,23,24,26,27,29-39,45-50,53,54,56,57,59,60, and 62-67 rejected under 35 U.S.C. 102(e) as being anticipated by Tsuei U.S. Patent 6,654,779.
3. Regarding claims 1,33, and 36, Tsuei discloses a method of indirectly forwarding a communication from a sender to a recipient where an old address for the recipient is known or believed to be temporarily or permanently invalid, by sending the communication to a forwarding service at an address different from that of the recipient (Abstract), comprising, at the forwarding service (eg. figure 3, EAMS), the steps of: receiving the communication (Figure 4, EAMS receive message from send ISP 445); looking up at least the old address in a database (Figure 4, EAMS perform lookup 450); retrieving at least one second address from the database, which second address is associated with the old address (Figures 3 and 4, EAMS retrieve the new address based on old email address, 342, and 344); sending the communication to the second address (Figure 4, EAMS forward message to the new email address 470).
4. Regarding claims 2 and 35, Tsuei discloses in which the old address is sent to the forwarding service as part of the forwarding address (Figure 4).

Art Unit: 2143

5. Regarding claims 3 and 37, Tsuei discloses the old address is a part of the communication, and further comprising the step, after step a, of extracting (inherently) the old address from the communication (Figure 4; col. 9, lines 59-64).
6. Regarding claim 4, Tsuei discloses the old address for the recipient is selected from a group comprising: a telephone number, an e-mail address, a postal address, a uniform resource locator, an IP address, an IP address plus at least one time and/or date and/or duration, a file name, a file name plus a location, an instant messaging ID, a pager ID, a personal digital assistant ID, a cellphone ID, a cable terminal ID, a direct broadcast terminal ID, a telex number, a teletype number, and an online chat user ID (Figure 3, 340).
7. Regarding claims 5 and 38, Tsuei discloses the second address (eg. new email address) is selected from a group comprising: a telephone number, an e-mail address, a postal address, a uniform resource locator, an IP address, a file name, a file name plus a location, an instant messaging ID, a pager ID, a personal digital assistant ID, a cellphone ID, a cable terminal ID, a direct broadcast terminal ID, a telex number, a teletype number, and an online chat user ID (Figure 3, 340).
8. Regarding claims 6 and 39, Tsuei discloses the communication is selected from a group comprising telephone calls, electronic mail messages, postal mail, instant messaging communications, internet protocol communications, web pages, computer file transfer protocols, video transmissions, paging transmissions, personal digital assistant transmissions, cellphone transmissions, cable transmissions, direct broadcast transmissions, telex and teletype communications, and online chat transmissions (Figure 3, internet 130).

Art Unit: 2143

9. Regarding claims 12 and 45, Tsuei discloses there is more than one second address associated with the old address, and step d is performed for more than one of the second addresses associated with the old address (col. 7, last paragraph through col. 8, 1<sup>st</sup> paragraph).
10. Regarding claims 13 and 46, Tsuei discloses if there is a password in the database associated with the new address, prior to forwarding the communication requesting a password from the sender, receiving a password supplied by the sender, comparing the password supplied by the sender to the password in the database, and only performing the sending step d if the comparison is successful (col. 6, lines 55 through col. 7, 1<sup>st</sup> paragraph).
11. Regarding claims 14 and 47, Tsuei discloses sending a communication to the sender with identifying material associated with the more than one second addresses retrieved in step c and requesting the sender to choose from among the more than one second addresses, accepting a choice from the sender selecting at least one of the more than one second addresses, sending the communication to the selected at least one of the more than one second addresses (col. 7, lines 31-52).
12. Regarding claims 15 and 48, Tsuei discloses the at least one second address was registered by the recipient (Figure 5).
13. Regarding claims 16,17,49, and 50, Tsuei discloses the recipient periodically updates the at least one second address, and periodic updating is done automatically (col. 6, lines 30-44).
14. Regarding claims 20 and 53, Tsuei discloses at least one second address was retrieved by the forwarding service from a source other than the recipient (Figure 4).

Art Unit: 2143

15. Regarding claims 21 and 54, Tsuei discloses the forwarding step (d) further comprises the step of including additional information in the communication (Figure 3; and col. 6, last paragraph through col. 7, 1<sup>st</sup> paragraph).

16. Regarding claims 23,24,55 and 57, Tsuei discloses the step of sending a confirming communication back to the sender, and the confirming communication comprises at least the second address to which the communication was forwarded (col. 7, lines 41-46).

17. Regarding claims 26 and 59, Tsuei discloses the old address and at least one second address are addresses in the same medium of communications (Abstract).

18. Regarding claims 27 and 60, Tsuei discloses in which the old address and at least one second address are addresses in different media of communications (Figure 3, 340).

19. Regarding claims 29 and 62, Tsuei discloses if the seconde retrieved in step c is invalid, of using the second address as an old address, and repeating the method from step b (Figure 4, 470 to 420 to 440).

20. Regarding claims 30 and 63, Tsuei discloses the communication is sent to the forwarding service by a server to which the communication was sent by the sender (Figure 4).

21. Regarding claims 31 and 64, Tsuei discloses the server is associated with the sender, and the mail server automatically sends the communication to the forwarding service when the communication is returned as undeliverable (Figure 4, 440).

22. Regarding claim 32 and 65, Tsuei discloses the server is a mail server associated with the old address associated with the recipient, and the mail server automatically sends the communication to the forwarding service when the mail server cannot deliver the communication to the old address (Figures 3 and 4).

Art Unit: 2143

23. Regarding claims 66 and 67, Tsuei discloses maintaining a database having a plurality of entries (Figure 3, 340), each entry representing a session during which the recipient was connected and storing at least the address dynamically assigned while the recipient was connected and the time during which the recipient was connected using that address, when a recipient connects, creating an entry in the database and linking the currently assigned address to an entry in the database for a previous connection (col. 6, lines 30-44); accepting a forwarding request from a sender, comprising at least an address and a time representing a previous connection associated with the recipient (Figure 4, EAMS perform lookup 450); using the address and time finding the entry in the database which represents the previous connection (Figures 3 and 4, EAMS retrieve the new address based on old email address, 342, and 344); returning the currently assigned address for the recipient which was linked to the entry found, and connecting the communication to the recipient (Figure 4, EAMS forward message to the new email address 470).

***Claim Rejections - 35 USC § 103***

24. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are, such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

25. Claims 7-11, 18-19, 28, 40-44, 51-52, and 61 rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuei in view of Fuisz U.S. Patent 6,643,688.

Art Unit: 2143

26. Regarding claims 7-11, and 40-44, Tsuei discloses retrieving at least one second address from the database, which second address is associated with the old address; however, Tsuei fails to teach the step of selecting one of the new addresses based on selection criteria such as a password supplied by the sender, a time of day, a priority ranking supplied by the recipient, and the second address returned is a second address having the highest priority, and a next-higher priority second address until a valid second address is found or all second addresses are returned.

Fuisz reference discloses the step of selecting one of the new addresses based on selection criteria such as a password supplied by the sender, a time of day, a priority ranking supplied by the recipient, and the second address returned is a second address having the highest priority, and a next-higher priority second address until a valid second address is found or all second addresses are returned (col. 2, lines 8-12; col. 2, lines 51-61; col. 3, lines 1-31; and col. 4, lines 37-60).

It would have been obvious to one of the ordinary skill in the art at the time of the invention was made to incorporate Fuisz's teaching into Tsuei's method to forward an email message based upon the condition selection technique; as a result, it ensures that email will continue to find its way to the intended recipient.

27. Regarding claims 18-19 and 51-52, Tsuei discloses the at least one second address was registered by the recipient; however, Tsuei fails to teach the recipient specifies at least one sender from whom the recipient does not wish to receive or not receive communications, and the sending step d of the method further comprises the step of not sending or sending communications to the at least one sender specified by the recipient.



Art Unit: 2143

Fuisz reference discloses the filtering technique which allow user's to create their own filter whether the user's want to receive or not receive message from a certain sender(s) (col. 8, lines 23-36).

It would have been obvious to one of the ordinary skill in the art at the time of the invention was made to incorporate Fuisz's teaching into Tsuei's method to apply the filtering technique Tsuei's invention to allow user with more flexibility to manage their email account.

28. Regarding claims 28 and 61, Tsuei discloses retrieving at least one second address from the database, which second address is associated with the old address; however, Tsuei fails to teach counting the number of communications forwarded for a sender in a selected time period, and not forwarding communications if the sender sends more communications to be forwarded during the selected time period than a selected limit.

Fuisz reference discloses counting the number of communications forwarded for a sender in a selected time period, and not forwarding communications if the sender sends more communications to be forwarded during the selected time period than a selected limit (col. 3, 1<sup>st</sup> paragraph).

It would have been obvious to one of the ordinary skill in the art at the time of the invention was made to incorporate Fuisz's teaching into Tsuei's method to count the number of forwarded e-mail so it can bills the user.

29. Claims 22,25,55, and 58, rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuei.

Tsuei discloses sending the communication to the second address further comprises the step of including additional information in the communication, and send the confirmation to the

Art Unit: 2143

sender; however, Tsuei fails to teach additional information is advertising, the confirming communication also comprises additional information at least in the form of advertising.

It would have been obvious to one of the ordinary skill in the art at the time of the invention was made to provide additional information such as advertising attach to the message to attract sender attention to a product or business.

### *Conclusion*

30. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

McCormick et al. U.S. Pat. No. 6,421,709 disclose e-mail filter and method thereof.

Redmond U.S. Pat. No. 6,370,139 discloses system and method for providing information dispersal in a network computing environment.

Mulligan et al. U.S. Pat. No. 5,937,161 disclose electronic message forwarding system.

Nielsen U.S. Pat. No. 6,405,243 discloses method and system for updating email addresses.

Reilly U.S. Pat. No. 6,427,164 discloses system and method for automatically forwarding electronic mail when the recipient is otherwise unknown.

Waskiewics U.S. Pat. No. 5,822,526 discloses system and method for maintaining and administering email address names in a network.

McDowell et al. U.S. Pat. No. 6,438,583 disclose system and method for re-routing of e-mail messages.

Art Unit: 2143

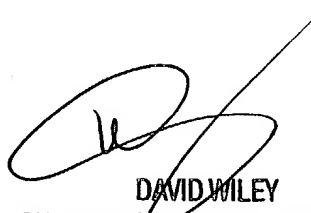
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phuoc H. Nguyen whose telephone number is 703-305-5315. The examiner can normally be reached on Mon -Thu (7AM-4: 30PM) and off every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A Wiley can be reached on 703-308-5221. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Phuoc H. Nguyen  
Examiner  
Art Unit 2143

September 16, 2004



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